

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

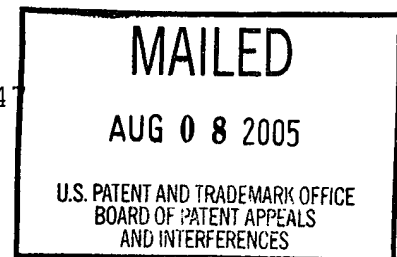
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUBHASH C. ROY, MICHAEL M. RENAULT,
FREDERICK R. CARTER, DAVID K. TOEBES and
RAJEN S. RAMCHANDANI

Appeal No. 2005-1012
Application No. 09/717,147

ON BRIEF



Before JERRY SMITH, BARRETT and KRASS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

Decision On Appeal

This is a decision on appeal from the final rejection of claims 1-5, 11-17, 23, and 24.

The invention is said to involve a communications switch having many features, and described in no less than five pending applications. The claims in the instant application are directed

Appeal No. 2005-1012
Application No. 09/717,147

specifically to the feature of arbitrating bandwidth in the communication switch. In particular, a repeating data frame having a plurality of rows is generated. Requests are made during row N for space in row N+1, and then the requests are granted through an out-of-band link.

Representative independent claim 1 is reproduced as follows:

1. A method for arbitrating bandwidth in a communications switch, comprising:

- a) generating a repeating data frame having a plurality of rows;
- b) making requests during row N for space in row N+1; and
- c) granting the requests through an out-of-band link.

The examiner relies on the following references:

Gorshe	5,412,651	May 2, 1995
Chiussi et al. (Chiussi)	5,689,506	Nov. 18, 1997
Chow et al. (Chow)	6,148,349	Nov. 14, 2000
Bergantino et al. (Bergantino)	6,359,891	Mar. 19, 2002 (filed Jun. 13, 2000)

Claims 1-5, 11-17, 23, and 24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Gorshe with regard to claims 1, 2, 12-14, and 24, adding Chiussi with regard to claims 3, 4, 15, 16. With regard to claims 5 and 17,

Appeal No. 2005-1012
Application No. 09/717,147

the examiner offers Gorshe and Bergantino, while, with regard to claims 11, and 23, the examiner offers Gorshe and Chow.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

With regard to independent claims 1 and 13, the examiner contends that Gorshe teaches the generation of a repeat data frame having a plurality of rows (at column 1, lines 44-46), making requests for space (at column 3, lines 29-37, column 6, lines 62-68, and Figure 5), and granting the requests through an out-of-band link (at lines 521-533 of Figure 5). In fact, the examiner asserts, Gorshe only lacks a specific disclosure of the requests being made during row N for space in row N+1.

The examiner contends that it would have been obvious that "the request be made during row N for space in row N+1 because space could be provided in any row subsequent to row N and no unexpected result is produced by providing space in row N+1" (answer-page 3).

Appellants' position focuses on the claim language of requesting during row N for space during row N+1. Appellants argue that any one user will make a request for space during a row N of the frame, in Gorshe, but the request is not a request

Appeal No. 2005-1012
Application No. 09/717,147

for space in row N+1. Appellants contend that a request is granted at the expiration of a counter in Gorshe and that it is unknown, at the time the request is made and at the time the request is granted, where a requester will be granted space in response to a request.

Appellants state that the examiner's position is flawed because "absent the present invention, it is not possible to provide space in row N+1 following a request in row N and that is why it is not shown or suggested in the prior art. Thus, contrary to the Examiner's assertion space could not be provided in any row subsequent to row N" (brief-page 6).

Appellants also point out that the examiner has "not provided any incentive for one skilled in the art to modify Gorshe" (brief-page 7).

In response, the examiner argues that in Gorshe "the request is made during row N for space in any row subsequent to row N [and] that includes row N+1. Therefore, Gorshe implicitly discloses making requests during row N for space in row N+1" (answer-page 5). Moreover, argues the examiner, the claims do not disclose whether the request will be rejected if the space available is, for example, in row N+2 instead of row N+1. That is, the examiner contends, "it seems like the claimed invention

Appeal No. 2005-1012
Application No. 09/717,147

is requesting for the best space available in rows subsequent to row N" (answer-page 5). The examiner further states that Gorshe's ability to provide space in row N+1 following a request in row N "is depending [sic, dependent] on a number of factors including the length of the row, the delay within the switch, the transmission speed, and the distance between the requester and the granter within the switch, none of those factors are mentioned in claims 1 and 13" (answer-page 5).

We have reviewed the evidence in this case, including the arguments of appellants and the examiner and we conclude therefrom that the examiner has failed to establish a prima facie case of obviousness with regard to the instant claimed subject matter.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed

Appeal No. 2005-1012
Application No. 09/717,147

invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

In the instant case, the claims specifically call for making requests during row N for space in row N+1. While Gorshe may

Appeal No. 2005-1012
Application No. 09/717,147

make a request for space in any row subsequent to row N, appellants have asserted that prior to this invention, space in the next row could not be granted and the examiner has not shown any evidence that such space could be granted in Gorshe.

One may argue that the claims merely call for making requests in row N for space in row N+1 but that does not necessarily mean that such space is available or that such requests will in fact be granted. However, the claims also specifically call for "granting the requests..." so, in fact, in accordance with the claim limitations, such requested space **is** granted.

Therefore, in order for the examiner to prevail, it must be shown that Gorshe either does grant requests made during row N for space in row N+1 or that it would have been obvious to do so in Gorshe. Clearly, there is no disclosure in Gorshe of making a request in row N for space in row N+1, so the examiner must show some teaching within Gorshe, or within the knowledge of the skilled artisan, that would have led the artisan to modify Gorshe so as to provide for such space in row N+1 in response to a request during row N. We are unconvinced by any reasoning by the examiner that it would have been obvious to so modify the teachings of Gorshe.

Appeal No. 2005-1012
Application No. 09/717,147

While Gorshe may have a provision for granting space in a row subsequent to row N, it appears that such space will be provided when it becomes available. There may even be requests for space in the next frame, but we find nothing to suggest making a request in one row for space in the very next row. In accordance with the instant claimed invention, requests are for space in the next row and not in any other row but the next row, unlike in Gorshe where there may be a request for space in a subsequent row, but there is nothing in Gorshe that would suggest requesting space only in the very next row, as claimed. Moreover, the examiner has made no convincing showing that it is even possible in Gorshe to make a request during one row for space in the very next row, and have that request granted.

The examiner's conclusion that since Gorshe teaches a request in row N for space in some subsequent row means that it would have been obvious to request space in row N+1 is simply not supported by any evidence of record.

Accordingly, we will not sustain the rejection of independent claims 1 and 13, nor of the claims dependent thereon, under 35 U.S.C. § 103, since neither Gorshe nor any of the other applied references provides for the deficiency of Gorshe, viz., the showing of a request in row N for space in row N+1.

Appeal No. 2005-1012
Application No. 09/717,147

The examiner's decision rejecting claims 1-5, 11-17, 23, and 24 under 35 U.S.C. § 103 is reversed.

REVERSED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett
LEE E. BARRETT

LEE E. BARRETT
Administrative Patent Judge

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Appeal No. 2005-1012
Application No. 09/717,147

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